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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,356	06/25/2003	Thomas Daly		2566

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Naperville, IL 60540

EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,356

Applicant(s)

DALY, THOMAS

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-35 are pending.

Election/Restrictions

1. The claims encompass a number of distinct and independent inventions claimed in a form that are incomplete as to structure and employ improper alternative (Markush) groupings, which renders the claimed invention unclassifiable as a single group. The following groups have been provided as guidance as far as the claimed invention may be understood.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims drawn to compounds and compositions with polysiloxane groups, classified in class 556, subclass 400+.
 - II. Claims, drawn to carbamate-containing compounds and compositions, classified in class 560, subclass 132+.
 - III. Claims, drawn to polyurea containing compounds and compositions, classified in class 564, subclass 58+.
 - IV. Claims, drawn to acyclic nitro-containing compounds and compositions, classified in class 568, subclass 924+.
 - V. Claims, drawn to alkylamine containing compounds and compositions, classified in class 564, subclass 463+.
 - VI. Claims, drawn to alkylamide-containing compounds (assumed to be carboxamides) and compositions, classified in class 554 or 564, subclass 35+ or 123+.

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- VII. Claims, drawn to alkylquat-containing compounds and compositions, classified in class 564, subclass 291+.
- VIII. Claims, drawn to alkanol-containing compounds and compositions, classified in class 568, subclass 704+.
- IX. Claims, drawn to ether and polyether-containing compounds and compositions, classified in class 568, subclass 579+.
- X. Claims, drawn to ketones-containing compounds and compositions, classified in class 568, subclass 303+.
- XI. Claims, drawn to carboxylic acid, ester and polyester-containing compounds and compositions, classified in class 554 or 560, subclass 1+ or 1+.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of the various groups are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have divergent uses and effects as a metal working base, surfactants, foaming agents, defoaming agents. Each of the compounds would have different properties based on their different possible structures, which would preclude use of said compounds in all the intended uses and/or may be used as an antimicrobial without preference to their use in any of the preceding utilities.

Election of species

4. Claims 1-35 are generic to a plurality of disclosed patentably distinct species within the above groups comprising a number of possible permutations of the substituents, wherein R and R' may each independently be polysiloxanes, hydrocarbon groups, amines, ethers, esters, polyethers, polyesters, arylalkyl, carboxylic acids, ketones, and further bromo or nitro substituted species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

A proper election would include a single disclosed compound including single disclosed substituents for each of R, R', and if and where any further bromo- or nitro- substituents occur within any of the above restricted groups above. What is meant by a single disclosed substituent could be represented by examples, such as the use of oleic acid in example 1 for both R and R'. Alternatively, a single disclosed compound could be represented by the figures.

To the extent the elected species may not have each of the properties or functions for use in the metal working fluid base, surfactant, or foaming or anti-foaming agent, applicants should specify the application said elected species may be applicable.

Applicants should amend the present claims or provide a claim to read on the claimed restricted group and species within said group.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the

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record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

It is noted that the product-by-process claims (27-35) have been included with the products that may be formed falling within the claimed structures (1-26). Said claims will be examined to the extent said claims read on the elected species. Applicants should provide a list of the claims they believe to read on and/or generic to the elected species.

5. The restriction and election may require further restriction or collapse of some groups as a result of any amendments.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM